

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed December 1, 2006 (the "Office Action"). At the time of the Office Action, Claims 1-4, 6, and 9 were pending in the Application. Claims 1-4, 6, and 9 were rejected. Applicants amend Claim 1. Applicants respectfully request reconsideration and favorable action in this case.

Section 112 Rejections

First, the Examiner rejects Claims 1, 3, and 9 (and Claims 2, 4, and 6 as depending from these claims) under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. Second, the Examiner rejects Claim 1 under 35 U.S.C. § 112, second paragraph because the element "in the macro language statement" in the second claim limitation lacks antecedent basis. Applicants have amended Claim 1 to replace the identified claim element with "in the macro language expression." Accordingly, Applicants submit that the antecedent basis issues identified by the Examiner have been corrected. With regard to the Examiner's determination that the claims are incomplete as omitting essential steps, Applicants respectfully traverse the rejection of Claims 1-4, 6, and 9 on this basis.

A rejection under 35 U.S.C. § 112, second paragraph, for omitting essential steps is proper if the claim "fails to interrelate essential elements of the invention as defined by applicant(s) in the specification." See *M.P.E.P. § 2172.01*, citing *In re Venezia*, 530 F.2d 956 (C.C.P.A. 1976). The Office Action fails to provide any support for the contention that any omitted steps were "defined by the specification" and thus are necessary to interrelate essential elements of the invention, as required to support a rejection under 35 U.S.C. § 112, second paragraph. If the Examiner intends to maintain this rejection, Applicants respectfully request that the Examiner cite the specific portion of the specification that defines essential elements that must be interrelated for the claims to be proper under 35 U.S.C. § 112, second paragraph.

Claims 1, 3, and 9 are definite without amendment in that the meaning of these claims would be clear to one of ordinary skill in the art such that these claims comply with 35 U.S.C. § 112, second paragraph. See *M.P.E.P. § 2173.02*. In the Office Action, the Examiner

suggests that another step is needed at the end of Claim 1 and such step should include “retrieved executable code” and “without recompiling the macro language.” (Office Action, page 2). Specifically, the Examiner states that “[t]here needs to be a connection in the claim limitations after the ‘retrieved executable code’ is executed to run.” (Office Action, page 2). Even if each claim element is not interrelated (which Applicants do not concede), “it is not essential to a patentable combination that there be interdependency between the elements of the claimed device or that all the elements operate concurrently toward the desired result.” *See Ex parte Nolden*, 149 U.S.P.Q 378, 380 (Bd. Pat. App. 1965). “A claim does not necessarily fail to comply with 35 U.S.C. 112, second paragraph where the various elements do not function simultaneously, are not directly functionally related, do not directly intercooperate, and/or serve independent purposes.” *See Ex parte Huber*, 148 U.S.P.Q 447, 448-49 (Bd. Pat. App. 1965).

Furthermore, Applicants respectfully contend that the claims do not fail to interrelate essential elements of the invention. For example, Claim 1 is directed toward a method for providing an extensible macro language that includes a number of method steps. The method steps following the preamble are the steps undertaken for providing an extensible macro language. In other words, in a particular embodiment, providing an extensible macro language includes those method steps. Specifically, in a particular embodiment, providing an extensible macro language includes “determining. . . one or more keywords in a macro language expression,” “retrieving, from a registry of keywords and associated executable codes, an executable code associated with each keyword in the macro language statement,” and “executing each retrieved executable code to run the extended macro command associated with each of the one or more keywords in the macro language expression without recompiling the macro language.” No further steps after executing the retrieved executable code to run the extended macro command are omitted matter that is disclosed to be essential to the invention as described in the specification.

Additionally, Applicants note the Examiner’s indication that an “extensive search” will be performed “after the amendments have been made to the claims.” (Office Action, page 4). As discussed above, Applicants have shown that the claims as unamended in this

Response to Office Action are in compliance with 35 U.S.C. § 112, second paragraph. Section 2173.06 of the M.P.E.P states:

All words in a claim must be considered in judging the patentability of a claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q 494 (C.C.P.A. 1970). The fact that terms may be indefinite does not make the claim obvious over the prior art.

The M.P.E.P. confirms that “where the degree of uncertainty is not great, and where the claim is subject to more than one interpretation and at least one interpretation would render the claim unpatentable over the prior art, an appropriate course of action would be for the Examiner to enter two rejections (A) a rejection based on indefiniteness under 35 U.S.C. § 112, second paragraph; and (B) a rejection over the prior art based on the interpretation of the claims which renders the prior art applicable.” M.P.E.P. § 2173. Such an approach “is recommended [by the M.P.E.P.] from an examination standpoint because it avoids piecemeal examination in the event that the examiner’s 35 U.S.C. 112, second paragraph rejection is not affirmed, and may give applicant a better appreciation for relevant prior art if the claims are redrafted to avoid the 35 U.S.C. 112, second paragraph rejection.” *Id.*

In the present case, the degree of uncertainty is not great. As stated above, the claims clearly recite a method for providing an extensible macro language that includes a number of method steps. In particular embodiment, as recited in Claim 1, providing an extensible macro language includes “determining. . . one or more keywords in a macro language expression,” “retrieving, from a registry of keywords and associated executable codes, an executable code associated with each keyword in the macro language statement,” and “executing each retrieved executable code to run the extended macro command associated with each of the one or more keywords in the macro language expression without recompiling the macro language.” Because the claims are not uncertain, a rejection over the prior art would have been appropriate in this Office Action were such prior art applicable. Since no prior rejection was included in the Office Action, Applicants assume that the Examiner has not found prior art to be applicable at this stage of the prosecution. Because Applicants believe that the claims are definite within the meaning of 35 U.S.C. § 112, second paragraph, Applicants request that the rejection be withdrawn and the claims allowed. However, should an extensive search be performed and prior art be found to be applicable,

Applicants respectfully request that any future Office Action citing a prior art rejection be made not final. Since Applicants have not substantively amended the claims, Applicants' amendments could not make such a final rejection appropriate at this time. A final rejection citing a new prior art rejection would result in the sort of piecemeal examination that the M.P.E.P. warns against.

For at least these reasons, Applicants respectfully request that the rejection of Claim 1 under 35 U.S.C. § 112, second paragraph be withdrawn. For analogous reasons, Applicants also request that the rejection of Claims 3 and 9 be withdrawn. As Claims 1, 3, and 9 are proper under 35 U.S.C. § 112, second paragraph, the rejection of dependent Claims 2, 4, and 6 should also be withdrawn.

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other apparent reasons, Applicants respectfully request full allowance of all pending Claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Applicants believe no fee is due. However, should there be a fee discrepancy, the Commissioner is hereby authorized to charge any required fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicants



Jenni R. Moen
Reg. No. 52,038
Phone: (214) 953-6809

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CORRESPONDENCE ADDRESS:

Customer Number: **05073**